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09/918,566	08/01/2001	Adrian Yip	12177/21401	3564

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KENYON & KENYON  
1500 K STREET, N.W., SUITE 700  
WASHINGTON, DC 20005

EXAMINER

TIEU, BINH KIEN

ART UNIT	PAPER NUMBER
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2643

DATE MAILED: 06/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/918,566

Applicant(s)

YIP ET AL.

Examiner

BINH K. TIEU

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 5-17 is/are rejected.
- 7) ☐ Claim(s) 3 and 4 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 4 & 6.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Objections*

1. **Original claim 5 is missing**. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 6-16 have been renumbered 5-15.

2. Claim 1 is objected to because of the following informalities:

The “;” and “and” at the end of the claim should be deleted. An “.” period should be added the end. Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 4, renumbered claim 7 and renumbered claim 17, each recites the limitation, which has an insufficient antecedent basis for the limitation in the claim.

Claim 4 recites “said telephone service provider” which does not clearly point out that “said telephone service provider” is either CLEC or ILEC.

Claim 7 recited “said data communications service” which is not previous recited in its independent claim 1.

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Claim 17 recited "the second telephone service provider network" (on the last line of the claim) is not consistent with "alternative network provider" as recited in the above portions of the claim.

Appropriate corrections are required.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-2, renumbered claims 5-6, 11, 13, 15 and 17 are rejected under 35

U.S.C. 102(e) as being anticipated by Allen (U.S. Pat. #: 6,160,880).

Regarding claim 1, Allen teaches a method for porting a telephone number, comprising:

connecting a network interface device (i.e., an automatic subscriber loop reconnection arrangement as shown in figure 3) to a first telephone service provider network (i.e., old provider), a second telephone service provider network (i.e., new provider), and to at least one user communications device (i.e., subscriber equipment at subscriber premises connected to link 42);

remotely controlling said network interface device, via the second telephone service provider network, to transfer a user telephone number, previously used for voice

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communications via the first telephone service provider network, from the first telephone service provider network to the second telephone service provider network (col.7, lines 17-21);

wherein said step of remotely controlling includes remotely controlling said network interface device to switch from communications lines interconnected with the first telephone service provider network to communications lines interconnected with the second telephone service provider network to provide voice communications service for the user via the user communications device (col.7, lines 41-58).

Regarding claim 2, note col.6, lines 53-67.

Regarding claim 5, note figure 3, col.7, lines 3-4.

Regarding claim 6, note col.7, lines 50-57.

Regarding claim 11, Allen teaches a method for porting a telephone number, comprising: receiving control signals, remotely transmitting a second telephone service provider network, to transfer a user telephone number, previously used for voice communications via the first telephone service provider network, from the first telephone service provider network to the second telephone service provider network (col.7, lines 17-21);

switching, in response to the received control signals, communications lines interconnected with the first telephone service provider network to communications lines interconnected with the second telephone service provider network to provide voice communications service for the user via the user communications device (col.7, lines 41-58).

Regarding claim 13, Allen teaches an apparatus for porting a telephone number, comprising:

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a network interface device (i.e., an automatic subscriber loop reconnection arrangement as shown in figure 3) interconnected to a first telephone service provider network (i.e., old provider), a second telephone service provider network (i.e., new provider), and to at least one user communications device (i.e., subscriber equipment at subscriber premises connected to link 42);

wherein said network interface device includes circuitry for receiving control signals, remotely transmitted from the second telephone service provider network, to transfer a user telephone number, previously used for voice communications via the first telephone service provider network, from the first telephone service provider network to the second telephone service provider network (col.7, lines 17-21);

wherein said network interface device includes circuitry for switching communications lines interconnected with the first telephone service provider network to communications lines interconnected with the second telephone service provider network to provide voice communications service for the user via the user communications device (col.7, lines 41-58).

Regarding claim 15, Allen teaches a system for porting a telephone number, comprising:

a second telephone service provider network that provides telephone service to a plurality of users as an alternative to a first telephone service provider network (i.e., new provider and old provider as shown in figure 3 or CLEC and ILEC; col.6, lines 53-67);

a network interface device (i.e., an automatic subscriber loop reconnection arrangement as shown in figure 3) interconnected to a first telephone service provider network (i.e., old provider), a second telephone service provider network (i.e., new provider), and to at least one

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user communications device (i.e., subscriber equipment at subscriber premises connected to link 42);

wherein said network interface device includes circuitry for receiving control signals, remotely transmitted from the second telephone service provider network, to transfer a user telephone number, previously used for voice communications via the first telephone service provider network, from the first telephone service provider network to the second telephone service provider network (col.7, lines 17-21);

wherein said network interface device includes circuitry for switching communications lines interconnected with the first telephone service provider network to communications lines interconnected with the second telephone service provider network to provide voice communications service for the user via the user communications device (col.7, lines 41-58).

Regarding claim 17, Allen teaches a method for porting a telephone number, comprising: providing telephone service to a plurality of users as an alternative to a first telephone service provider network (i.e., new provider and old provider as shown in figure 3 or CLEC and ILEC; col.6, lines 53-67);

connecting a network interface device (i.e., an automatic subscriber loop reconnection arrangement as shown in figure 3) to a first telephone service provider network (i.e., old provider), the alternative network (i.e., new provider), and to at least one user communications device (i.e., subscriber equipment at subscriber premises connected to link 42);

remotely transmitting control signals to the network interface device for transferring a user telephone number, previously used for voice communications via the first telephone service

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provider network, from the first telephone service provider network to the alternate provider network (col.7, lines 17-21); and

wherein said step of remotely transmitting includes remotely transmitting control signals to switch from communications lines interconnected with the first telephone service provider network to communications lines interconnected with the alternative service provider network, and to provide voice communications service via the first telephone service provider network until the user telephone number is transferred to the alternative telephone service provider network (col.7, lines 41-58).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).



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8. Renumbered claims 7-10, 12, 14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allen (U.S. Pat. #: 6,160,880) in view of Rajakarunanayake (U.S. Pat. #: 6,657,994).

Regarding claim 7, Allen teaches all subject matter as claimed above, except for said circuitry includes home phone network alliance circuitry to allow said data communications service. However, Rajakarunanayake teaches a derive voice customer premises equipment (DV-CPE) 110, as shown in figure 1, provided at a client premise 102 that allows data communications service (col.4, lines 18-31) for a purpose of providing high speed data transmission such as xDSL services.

Therefore, it would have been obvious to one of ordinary skill in the art the time the invention was made to incorporate the use of DV-CPE as said circuit includes home phone network alliance circuitry to allow said data communications service, as taught by Rajakarunanayake, into view of Allen in order to provide high speed data transmission such as xDSL services to subscribers.

Regarding claim 8, Rajakarunanayake further teaches limitations of the claim in col.6, line 52 – col.7, line 3.

Regarding claims 9-10, Rajakarunanayake further teaches limitations of the claim in col.4, line 17 – col.5, line 8; and col.6, line 52 – col.7, line 3.

Regarding claims 12, 14 and 16, Rajakarunanayake further teaches limitations of the claim in col.4, line 17 – col.5, line 8; and col.6, line 52 – col.7, line 3.

*Allowable Subject Matter*

9. Claims 3 and 4 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binh K. Tieu whose telephone number is (703) 305-3963 and E-mail address: [BINH.TIEU@USPTO.GOV](mailto:BINH.TIEU@USPTO.GOV).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Curtis Kuntz, can be reached on (703) 305-4708 and **IF PAPER HAS BEEN MISSED FROM THIS OFFICIAL ACTION PACKAGE, PLEASE CALL Customer Service at (703) 306-0377 FOR THE SUBSTITUTIONS OR COPIES.**

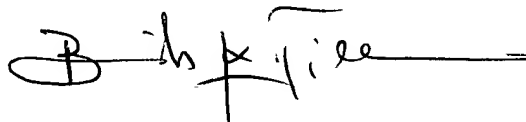
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Or faxed to:

(703) 872-9314

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington VA, Sixth Floor (Receptionist, tel. No. 703-305-4700).



**BINH TIEU  
PRIMARY EXAMINER**

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Date: June 01, 2004